



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,587	04/20/2001	Robert Sage Blackman	20313-011	1413

24341 7590 07/11/2005

MORGAN, LEWIS & BOCKIUS, LLP.  
2 PALO ALTO SQUARE  
3000 EL CAMINO REAL  
PALO ALTO, CA 94306

EXAMINER
----------

VEILLARD, JACQUES

ART UNIT	PAPER NUMBER
----------	--------------

2165

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/839,587

Applicant(s)

BLACKMAN ET AL.

Examiner

Jacques Veillard

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the Applicant's amendment filed on 4/15/2005.
2. Claims 1-42 have been amended.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-42, filed on 4/15/2005, have been fully considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-42 rejected under 35 U.S.C. 103(a) as being unpatentable over Shirley et al. (U. S. Pat. No. 5,692,206) in view of Goshey et al (U. S. Pat. No. 6,327,613).

As per claim 1, Shirley et al. disclose, "a method and apparatus for automating the generation of a legal document" by providing a contract generation system that automates the generation of various legal documents, related to a negotiated agreement (See Shirley et al. Title and Abstract). In particular, Shirley et al. disclose the claimed limitations of "formulating a request by a first party for an agreement with a second party, the request containing an agreement ID that uniquely identifies the request and any agreement formed therefrom"(See Shirley et al. col.12, lines 32-38, Figs.7, 9 and corresponding text, Fig.11B, components 860,

Art Unit: 2165

866, 872 and corresponding text). Also Shirley et al. disclose the claimed limitations of “sending the request to the second party” (See Shirley et al. Abstract, col.3, line 56 through col.4, line 24); “receiving correspondence from the second party regarding the request or any agreement formed therefrom” (See Shirley et al. (See Shirley et al. col.10, lines 7-16). Further, disclose the claimed limitations of “saving the correspondence from the second party according to the unique agreement ID” (See Shirley et al. col.10, lines 16-18 and lines 54-62).

It is noted, however, Shirley et al. did not specifically disclose a first client computer system and a second client computer system connected over a computer network. On the other hand, Goshey et al. achieved this claimed feature by providing a method for sharing peripheral devices over a network wherein a number of computers coupled together via a file server connected the network (See Goshey et al. Fig.1, col.1, lines 34-67, col.2, lines 34-58, col.4, lines 32 through col.5, line 64, and col.6, lines 12-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method for automating the generation of a legal document of Shirley et al. by incorporating a first computer and a second computer system connected via a network as taught by Goshey et al. The motivation being to have enhanced the system of Shirley et al. by allowing it to use a first computer and a second computer connected via a network permitting a first party and a second party to communicate in order to share information via a network computer (See Goshey et al. col.2, lines 44-58).

As per claim 36, the claim has substantially the same limitations as claim 1. These limitations have already been discussed in the rejection of claim 1. In addition, the combination

Art Unit: 2165

of Shirley et al. and Goshey et al., as modified, disclose, the claimed limitations of “linking the second agreement to the first agreement by including the first agreement ID” (See Shirley et al. col.10, lines 19-28 and col.12, lines 32-38) and the claimed limitations of “in the field identifying a downstream agreement to form a supply chain among the first, second and third parties” (See Shirley et al. col.7, lines 22-40, and Fig.7 col.8, lines 18-48). Therefore, it is rejected on similar grounds corresponding to the argument given for the rejected claim 1 above.

As per claims 2 and 24, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of “wherein the first party has an independent agreement database” (See Shirley et al. Fig.2 component 202 correspond to an independent agreement database); further including the step of storing the request in the agreement database in a record that includes or is linked to the agreement ID, after formulating the request (See Shirley et al. col.4, lines 40-58); and wherein the step of saving the correspondence from the second party includes storing the second party correspondence in the agreement database of the first party in a record that includes or is linked to the agreement ID (See Shirley et al. col.10, lines 16-22).

As per claims 3, 12, 25 and 31, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of “wherein the correspondence from the second party includes information relating

Art Unit: 2165

to a counter offer, a request for clarification, an acceptance or a rejection of the request or a notification that the correspondence from the second party will be delayed” (See Shirley et al. 10, lines 1-17).

As per claims 4, 9, 13 and 18, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of “wherein the correspondence from the second party is encapsulated in an electronic mail message that contains the agreement ID” (See Shirley et al. Fig. 1B component 124, col.4, line 65 and Fig.8 component 722 and col.4, lines 59-65).

As per claims 5, 8, 26, 29, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of “wherein the correspondence from the second party includes a main body of information and an attachment to the main body; and wherein the attachment is according to the agreement ID” (See Shirley et al.col.5, lines 31-46).

As per claims 6 and 27, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of “wherein the correspondence from the second party includes information unrelated

Art Unit: 2165

to the formation or modification of the agreement, yet still related to the agreement” (See Shirley et al. Fig. 11B components 862, 868, 874 and corresponding text).

As per claims 7, 16, 22, 28, and 34, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of “wherein the correspondence from the second party is taken from the group consisting of: a facsimile transmission, an electronic mail message, a letter sent by post, or an HTML document”(See Shirley et al. Fig.1B component 124, col.4, line 65 and Fig.8 component 722 and col.12, lines 3-18).

As per claims 10, 14, 17, 23, 30, 32, and 35, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of “sending correspondence from the first party to the second party relating to the request or any agreement derived therefrom” (See Shirley et al. Fig.1B component 124, col.4, line 65 and Fig.8 component 722 and col.12, lines 3-18); and “saving the correspondence from the first party relating to the request according to the unique agreement ID given the request” (See Shirley et al. abstract, Fig.7 component 660 and col.9, lines 27-30).

As per claims 11, 19, and 20, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In

Art Unit: 2165

addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of “wherein the step of saving the correspondence from the first party relating to the request includes storing the first party correspondence in the agreement database of the first party in a record that includes or is linked to the agreement ID” (See Shirley et al. Abstract, Fig.12C component 936. and col.19, lines 4-18).

As per claims 15, 21, and 33, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant’s attention is directed to the rejection of claim 1 above. In addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of “wherein the correspondence from the first party includes information unrelated to the formation or modification of the agreement, yet still related to the agreement”(See Shirley et al. Fig.7, and col.4, lines 40-58).

As per claims 37 and 39, most of the limitations of this claim have been noted in the rejection of claim 36. Applicant’s attention is directed to the rejection of claim 36 above. In addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of “wherein the step of linking includes: specifying the first deliverable in the second request based on the deliverables of a list of customers” (See Shirley et al. col.10, lines 48-62 and col.17, lines 1-17), “each having a deliverable due from the second party” (See Shirley et al. Abstract, col.3, line 56 through col.4, line 24); and “obtaining the first agreement ID based on the deliverable specified” (See Shirley et al. col.10, lines 7-16).

As per claims 38 and 40, most of the limitations of this claim have been noted in the rejection of claim 36. Applicant's attention is directed to the rejection of claim 36 above. In addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of "wherein the step of formulating the second request includes specifying a second deliverable and a date and time for the second deliverable" (See Shirley et al. col.2, lines 14-18, col.10, lines 10-12 and lines 52-62); and "specifying the first deliverable in the second request based on the deliverables of a list of customers" (See Shirley et al. col.10, lines 48-62 and col.17, lines 1-17), "each having a deliverable due from the second party with a due date and time subsequent to the date and time of the second deliverable" (See Shirley et al. col.2, lines 14-18, col.10, lines 10-12 and lines 52-62); and "obtaining the first agreement ID based on the deliverable specified" (See Shirley et al. See Shirley et al. col.10, lines 7-16).

As per claims 41 and 42, most of the limitations of this claim have been noted in the rejection of claim 36. Applicant's attention is directed to the rejection of claim 36 above. In addition, the combination of Shirley et al. and Goshey et al., as modified, discloses the claimed limitations of "wherein the step of formulating the second request includes specifying a folder and a second deliverable" (See Shirley et al. Fig.1B component 200, Fig.5 component 200, Fig.8, Fig.9, col.6, lines 30-41, line 56 through col.7, lines 13, and col.12, line 28 through col.13, line 8); and "specifying the first deliverable in the second request based on the deliverables of a list of customers included in the specified folder" (See Shirley et al. col.10, lines 48-62 and col.17, lines 1-17); and "obtaining the first agreement ID based on the deliverable specified" (See Shirley et al. col.10, lines 7-16).

Art Unit: 2165

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Other Prior Art Made Of Record***

- |    |                  |                               |
|----|------------------|-------------------------------|
| 6. | Larson et al.    | U. S. Pub. No. 2004/0103205,  |
|    | Giorgio et al.   | U. S. Pat. No. 5,991,829, and |
|    | Cwikowski et al. | U. S. Pat. No. 5,325,527.     |

***Conclusion***


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086. The examiner can normally be reached on Mon. to Fri. from 9 AM to 4:30 PM, alt. Fri. off..

Art Unit: 2165

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272- 4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEFFREY GAFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

J.V  
Jacques Veillard  
Patent Examiner TC 2100

June 29, 2005